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Paper No. 7

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OFFICE OF PETITIONS

In re Application of :
Rocky Stemart et al. :
Application No. 09/785,862 :
Filed: February 16, 2001 :
Attorney Docket No. :

ON PETITION

This is in response to the petition under 37 CFR 1.47(a), filed July 16, 2001.

The petition is dismissed.

Rule 47 applicant is given TWO MONTHS from the mailing date of this decision to reply, correcting the below-noted deficiencies. Any reply should be entitled "Request for Reconsideration of Petition Under 37 CFR 1.47(a)," and should only address the deficiencies noted below, except that the reply may include an oath or declaration executed by the non-signing inventor. **FAILURE TO RESPOND WILL RESULT IN ABANDONMENT OF THE APPLICATION.** Any extensions of time will be governed by 37 CFR 1.136(a).

A grantable petition under 37 CFR 1.47(a) requires: (1) proof that the non-signing inventor cannot be reached or refuses to sign the oath or declaration after having been presented with the application papers (specification, claims and drawings); (2) an acceptable oath or declaration in compliance with 35 U.S.C. §§ 115 and 116; (3) the petition fee; and (4) a statement of the last known address of the non-signing inventor.

By declaration of attorney Karl Kenna, applicants set forth the facts relied on to conclude that inventor Metsaportti refuses to join in the application. Attorney Kenna detailed unsuccessful attempts to contact inventor Metsaportti by email and telephone, as well as, delivery of the application papers to inventor Metsaportti's last known address via Federal Express on April 30,

2001. In support of the petition, applicant submitted a copy of the FedEx email conformation of delivery.

These facts have been considered but not found adequate to show that inventor Metsaportti refuses to join in the application. Applicant has not distinguished whether inventor Metsaportti's nonresponsiveness is due to a refusal on his part to join in the application or whether applicant has simply not been reached to respond. Applicant received no response to emails. The telephone number at which applicant was attempting to contact the inventor proved to be invalid. The application papers were not signed for by inventor Metsaportti, but by a "Irene Summanen." Thus, it cannot be concluded that the application papers were presented to inventor Metsaportti, and by his conduct, he has refused to join in the application.

Before a refusal can be alleged, applicants must demonstrate that a bona fide attempt was made to present a copy of the application papers (specification, including claims, drawings, and oath or declaration) to the non-signing inventor. See Manual of Patent Examining Procedure, Section 409.03(d). It is likely from the evidence submitted that the address to which applicant sent the application papers, like the telephone number obtained from BEA Systems, Inc., was at the time invalid. Further efforts to locate inventor Metsaportti and to present the application papers to him at a valid address (or establish that the address to which the papers were delivered is valid) are warranted. If diligent efforts to obtain a forwarding address or to locate the non-signing inventor by other means such as through the telephone, or the Internet continue to fail, then applicant will have provided the necessary proof required under 37CFR 1.47 that the inventor cannot be reached. Details of the efforts to locate the non-signing inventor should be set forth in an affidavit or declaration of facts by a person with first hand knowledge of the details. Applicant should submit documentary evidence such as the results of a telephone directory or an Internet search. However, if the non-signing inventor is located at another address, a copy of the application papers should be sent to him at the address, or, if it is determined that the inventor is represented by counsel, to the address of the non-signing inventor's attorney. Documentary evidence, including copies of the transmittal cover letters and return mail receipts, should be made part of the record.

Moreover, clarification is required regarding the declaration filed July 16, 2001, and citizenship listed thereon of inventor Metsaportti. In the email communications to inventor Metsaportti dated April 17 and 24th, 2001 (Exhibits A & B) respectively, attorney for applicant, through his assistant, communicates that we do not have the citizenship of inventor Metsaportti. In his declaration, attorney Kenna states that he received no response to these emails. No other evidence of record establishes how this information was obtained.

In order to expedite consideration of the petition under 37 CFR 1.47(a), petitioner may wish to submit the renewed petition by facsimile transmission to the telephone number indicated below and to the attention of Irvin Dingle.

Further correspondence with respect to this matter should be addressed as follows:

By mail: Assistant Commissioner for Patents
Box DAC
Washington, D.C. 20231

By FAX: (703) 308-6916
Attn: Office of Petitions

By hand: Crystal Plaza Four, Suite 3C23
2201 S. Clark Place
Arlington, VA 22202

Telephone inquiries related to this decision should be directed to Irvin Dingle at (703) 306-5684.

Frances Hicks

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